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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,141	07/20/2001	Peter Emig	0691-070	9859

23622 7590 06/16/2003

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ROSELAND, NJ 07068

EXAMINER

HABTE, KAHSAY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/16/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/910,141

Applicant(s)

EMIG ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-11, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. Claims 1-11 and 13-14 are pending.

### *Response to Amendment*

2. Applicants' amendments filed 12/20/02 and 5/23/03 in response to the previous Office Actions (Paper No. 9 and 13) are acknowledged. Rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph (Paper No. 9, paragraphs 5a-5b) have been obviated. Rejection of claim 12 (Paper No.9, item 4) has been also obviated. The prior art rejection is maintained (Paper No. 9, item 3).

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action. Applicants have to limit their invention to diazines (i.e.  $X = N$  and the sum of  $m$  and  $n = 2$ ). Applicants have also to delete the proviso that refers to  $X = CR^5R^6$ .

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugihara et al. (US Pat. No. 4,937,246). The cited reference discloses on column 23 (WORKING EXAMPLE 11) the synthesis of 1-(2-quinolylcarbonyl)-4-(3,4,5-trimethoxybenzyl)piperazine dihydrochloride that is the same as applicants, when applicant's formula (1) has the following substituents: R,<sup>1</sup>R<sup>2</sup>R<sup>3</sup>=H, Z=O, n=2, m=0, and R<sup>4</sup> is trimethoxy substituted benzyl.

### ***Response to arguments***

Applicants' arguments filed 12/20/2002 (Paper 9, item 3) have been fully considered but they are not persuasive.

Applicants argue "the compound of Example 11 of Sugihara et al. is 3,4,5-trimethoxybenzyl compound, and such a substitution is not possible for R<sup>4</sup> of the present invention which is a straight-chain or branched (C<sub>1</sub>-C<sub>20</sub>)-alkyl." The examiner disagrees with applicants. R<sup>4</sup> of the present invention which is a straight-chain or branched (C<sub>1</sub>-C<sub>20</sub>)-alkyl is one choice, but R<sup>4</sup> can be also "C<sub>6</sub>-C<sub>14</sub> aryl -C<sub>1</sub>-C<sub>4</sub> alkyl....that can be substituted by C<sub>1</sub>-C<sub>6</sub> alkoxy. Thus, R<sup>4</sup> can be 3,4,5-trimethoxybenzyl i.e. R<sup>4</sup> is C<sub>6</sub>aryl -C<sub>1</sub>alkyl substituted by trimethoxy at 3,4, and 5 positions of the benzyl ring.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Objection***

5. Claims 7-11 and 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

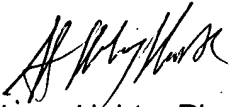
#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

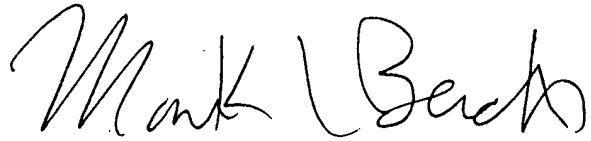
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624



Mark L. Berch  
Primary Examiner  
Art Unit 1624

KH  
June 12, 2003